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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,174	03/06/2002	Kevin Girard Conwell	13019	8623

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CHICAGO, IL 60604

EXAMINER

NGUYEN, PHUNG

ART UNIT	PAPER NUMBER
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2632

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,174

Applicant(s)

CONWELL ET AL.

Examiner

Phung T Nguyen

Art Unit

2632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 4, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin (U.S. Pat. 5,884,425) in view of Conwell et al. (U.S. Pat. 6,462,765).

Regarding claim 1: Baldwin discloses an anti-tamper tag with theft protection comprising a tamper evident label material 45, with an adhesive 28 on a back side, and an RFID transponder 66 adhered to the adhesive (figure 5, col. 7, lines 6-16). Baldwin does not disclose the tamper evident label material is a vinyl with a tensile and tear resistance such that the tamper label material one of tears and breaks upon an attempted removal from a substrate. However, using a vinyl as the tamper evident label material is old and known in the art as taught by Conwell et al. (col. 2, lines 21-28). Therefore, it would have been obvious to the skill artisan to utilize the teaching of Conwell et al. in the system of Baldwin because if the label material is made of vinyl, it would be easy to crack and break when removal from a substrate is attempted so that tampering is indicated.

Regarding claim 3: The combination does not disclose the tamper evident label material is 3M 7610 Scotch Destructible Vinyl as claimed. However, it would have been obvious to use 3M 7610 Scotch Destructible Vinyl as the tamper evident label material since they are commercially available in the market.

Regarding claim 4: Baldwin discloses a release liner 58 attached to the adhesive (figure 5, col. 7, lines 6-10).

Regarding claim 14: Baldwin discloses a release liner 58 attached to the adhesive (figure 5, col. 7, lines 6-10).

3. Claims 5, 6, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin in view of Conwell et al. and further in view of Mandecki (U.S. Pat. 5,981,166).

Regarding claim 5: The combination does not disclose a hologram on the label material. However, Mandecki discloses a screening of soluble chemical compounds for their pharmacological properties utilizing transponders comprising the holographic encoding of an image of serial number (col. 4, lines 57-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of Mandecki in the system of Baldwin and Conwell et al. because they both teach a system for security purpose which uses a transponder for transmission of data by reception of a predetermined signal. It is seen that using of holographic images would be an advantage for protecting articles from theft and for authenticating them.

Regarding claim 6: Mandecki discloses microprinting on the label material (col. 4, lines 55-57).

Regarding claim 15: Refer to claim 5 above.

Regarding claim 16: Refer to claim 6 above.

4. Claims 7, 8, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin (U.S. Pat. 5,884,425) in view of Zarembo et al. (U.S. Pat. 5,477,219).

Regarding claim 7: Baldwin discloses a clear label material with a pigmented adhesive 28 on a back side, and an RF transponder 66 adhered to the adhesive (col. 7, lines 6-10). Baldwin does not disclose the separation of the tag from a substrate results in incomplete separation of the adhesive in the form of the silicone pattern and the pattern becomes visible as claimed. However, Zarembo et al. disclose a composite electronic article surveillance, identification, and security marker assembly and system comprising a layer of retroreflecting beads (silicone pattern) 14 as shown in figure 1, col. 3, lines 9-27. Therefore, it would have been obvious to the skilled artisan to employ the technique of Zarembo et al. in the system of Baldwin because they both teach a system for protecting articles from theft. The teaching of Zarembo et al. would increase the flexibility of Baldwin's system by using a silicone pattern for identifying articles in order to prevent them from unauthorized removal.

Regarding claim 8: The combination does not disclose the tamper evident label material is one of 3M 7866, 3M 7389 and 3M 7385 as claimed. However, it would have been obvious to use one of 3M 7866, 3M 7389 and 3M 7385 as the tamper evident label material since they are commercially available in the market.

Regarding claim 17: Baldwin discloses a release liner 58 attached to the adhesive (figure 5, col. 7, lines 6-10).

Regarding claim 18: Refer to claim 17 above.

5. Claims 9, 10, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin in view of Zarembo et al. and further in view of Mandecki (U.S. Pat. 5,981,166).

Regarding claim 9: The combination does not disclose a hologram on the label material. However, Mandecki discloses a screening of soluble chemical compounds for their pharmacological properties utilizing transponders comprising the holographic encoding of an image of serial number (col. 4, lines 57-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of Mandecki in the system of Baldwin and Zarembo et al. because they teach a system for security purpose which uses a transponder for transmission of data by reception of a predetermined signal. It is seen that using of holographic images would be an advantage for protecting articles from theft and for authenticating them.

Regarding claim 10: Mandecki discloses microprinting on the label material (col. 4, lines 55-57).

Regarding claim 19: Refer to claim 9 above.

Regarding claim 20: Refer to claim 10 above.

6. Claims 11, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonough et al. (U.S. Pat. 5,920,290) in view of Bandy et al. (U.S. Pat. 6,002,344) and further in view of Makowka (U.S. Pat. 5,405,197).

Regarding claim 11: McDonough et al. disclose a resonant tag labels and method of making the same comprising a base film with a printed antenna 21 and an integrated circuit chip on a front surface (figure 4, col. 5, lines 7-22).

McDonough et al. teach the thin, frangible nature of the resonant tag label providing tamper evidence in the event that it is removed from a substrate to which it has been adhered (col. 6, lines 4-9) but do not disclose the base film having tear cuts whereby attempted removal of the RF transponder from a substrate causes the tear cuts to expand and to sever a connection between the printed antenna and the integrated circuit chip. However, Bandy et al. disclose a system and method for electronic inventory comprising tear lines 912 can be placed critical portions of the tag circuitry, such as antenna 302a, such that tag separation along tear line renders the tag inoperative (figure 9, col. 9, lines 64-67, and col. 10, lines 1-10). Therefore, it would have been obvious to the skilled artisan to combine the teachings of Bandy et al. and McDonough et al. because providing an indication of the unauthorized removal of the label, such as making the tag inoperative, would be an advantage.

The combination does not teach the base film having tear cuts at one or more edges of the base film. However, Malowka teaches a tamper-evident sealing system for envelope & method of making same comprising the edge tear resistance as seen in figure 7, col. 8, lines 15-41. Therefore, it would have been obvious to the skilled artisan to employ the teaching of Malowka in the system of McDonough et al. and Bandy et al. because the location of the tear cut is at one or more edges of the base film would result in a tearing of the film when someone attempt to remove the RF transponder from a substrate, thus provide evidence of tampering.

Regarding claim 13: Bandy et al. disclose applying a release liner to the adhesive (col. 10, lines 11-17).

Regarding claim 21: McDonough et al. disclose embedding the RFID transponder into a label material and applying an adhesive to a backside of the label material (col.5, lines 22-30).

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Cooley et al. [U.S. Pat. 5,660,925] disclose a tamper-indicating and authenticating label.

b. Suzuki [U.S. Pat. 6,572,022] discloses an information recording tag.

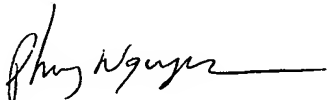
c. Peloquin et al. [U.S. Pat. 6,582,791] disclose a pressure sensitive adhesive for use on low energy surfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung T Nguyen whose telephone number is 703-308-6252. The examiner can normally be reached on 8:00am-5:30pm Mon thru. Friday, with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel J. Wu can be reached on 703-308-6730. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Examiner: Phung Nguyen



Date: December 30, 2003